

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-3 are now present in this application. Claim 1 is independent.

Amendments have been made to the Abstract of the Disclosure, claim 1 has been amended, and claims 2 and 3 added. No new matter is involved. Support for claims 2 and 3 is found throughout the originally filed application including, for example, page 5, lines 19-22, and Fig 2. Reconsideration of this application, as amended, is respectfully requested.

Applicant respectfully notes that this Amendment is a submission under 37 CFR §1.114(c) to be considered with a Request for Continued Examination (RCE) under 37 CFR §1.114 filed on even date herewith.

Request for Expedited Examination of the Petition under 37 CFR §1.181 filed on January 3, 2005 prior to or along with Examination on the merits of this Amendment to avoid Piecemeal Prosecution.

Applicant respectfully submits that the USPTO is engaging in improper piecemeal prosecution of this Application by requiring that Applicant respond to the merits of the final Office Action without responding on the merits to the Petition under 37 CFR §1.181, which seeks to correct the drawings, a favorable

decision on the petition being relied upon in this Amendment to correct the drawings.

Under the circumstances, Applicant respectfully requests that the next Office Action on the merits not be prepared and mailed unless and until a decision on Applicant's petition filed on January 3, 2005 is decided on its merits.

Priority Under 35 U.S.C. § 119

Applicant thank the Examiner for acknowledging Applicant's claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

Objection to the Drawings

The Examiner has objected to the drawings because the drawings in this Application do not show every feature of the claimed invention.

In order to overcome this objection, Applicant filed a Petition on January 3, 2005 to substitute proper drawings in this Application. The outstanding Office Action, dated May 6, 2005, states that the petition has been forwarded for decision. However, Examiner Bomberg indicated to Applicant's below-noted representative on October 24, 2005 that the Petition had not been forwarded to

the Office of Petitions until Examiner Bomberg kindly forwarded it on October 24, 2005.

Applicant respectfully submits that this delay in forwarding the petition for decision and the lack of a decision as of this late date is another reason why the outstanding Office Action should not have been made final.

Upon grant of the Petition, Applicant respectfully requests withdrawal of the drawing objection.

Abstract of the Disclosure

Applicant has amended the Abstract of the Disclosure in order to place it in better form.

Claim Objection

The Examiner has objected to claim 1 because of a grammatical informality. In order to overcome this objection, Applicant has amended claim 1 in order to correct the deficiency pointed out by the Examiner. Applicant has also amended claim 1 by removing the reference numerals, which the Office indicates in MPEP §608.01(m) do not affect the scope of the claim, and Applicant has amended claim 1 to place it in more idiomatic English and,

therefore, in better form. Reconsideration and withdrawal of this objection are respectfully requested.

Rejection under 35 U.S.C. § 103

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 1,591,678 to Garris in view of U.S. Patent 1,943,893 to Johnson and further in view of U.S. Patent 4,957,125 to Yaneza. This rejection is respectfully traversed.

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the Applicant to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *Id.*

As is well settled, a rejection based on Section 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the Examiner has the initial duty of supplying the factual basis for the rejection he advances. He

may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis, See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

In rejecting claims under 35 USC 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In doing so, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d

1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

The claimed invention is "a cosmetic case for storing liquid cosmetics." The claim preamble positively recites this and the body of the claim clearly refers back to the preamble by stating "so that the liquid cosmetics in the case body flows to the wetting part through the discharge tube."

The Court of Appeals for the Federal Circuit has stated that whether to

treat claim preamble language as a positively recited claim limitation is “resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim;” Corning Glass Works v. Sumitomo Electric USA, Inc., 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). The Court also stated that “Clear reliance on the preamble during prosecution to distinguish the claimed invention from prior art may indicate that the preamble is a claim limitation because the preamble is used to define the claimed invention.” Catalina Marketing International v. Coolsavings.com, Inc., 62 USPQ2d 1781, 1785 (Fed. Cir. 2002); Bristol-Meyers Squibb Co. v. Ben Venue Labs., Inc., 58 USPQ2d 1508, 1513 (Fed. Cir. 2001).

Accordingly, it is abundantly clear, that this feature of a cosmetic case for storing liquid cosmetics has to be given patentable weight in the examination of this patent application.

Unfortunately, none of the three applied references discloses a cosmetic case for storing liquid cosmetics. Garris discloses a shaving brush that has a receptacle for a shaving soap or paste. Shaving soaps or pastes are not cosmetics. Johnson discloses a brush for use with shaving creams and toothpaste. Yaneza discloses a toothbrush that dispenses toothpaste and dental floss. In other words, none of the three references discloses a cosmetic case for string liquid cosmetics. For this reason alone, any combination of these three references would not render the claimed invention obvious.

Moreover, these devices differ from one another in significant ways, i.e., in ways that teach away from combining them, as suggested in the Office Action.

Garris, the base reference, discloses a shaving soap or paste dispensing brush that is filled at the same end that it dispenses the shaving soap or paste. Garris' soap chamber 24 opens at the brush end by disconnecting tubular brush head 19 – see lines 69-80, for example. The soap is supplied to the interior center of the brush 20 from chamber 24 via passage 10. Garris' brush has no cap whatsoever and Garris does not disclose a cosmetics dispenser.

Yaneza, the secondary reference, discloses a toothbrush with a toothpaste dispenser that does not supply toothpaste to the inside of the toothbrush. Instead, to use Yaneza's toothbrush, the toothbrush 31 has to be unscrewed and separated from the toothpaste dispenser and toothpaste applied to the ends of the toothbrush bristles. A cover 13 is supplied, which clearly permits the toothbrush head to be maintained in a sanitary condition. Moreover, Yaneza does not disclose a cosmetics dispenser.

Johnson shows a shaving brush that supplies shaving cream to the interior center of shaving brush 2 via central passage 12 that is closed with a ball 11 and spring 13. Johnson's brush has no cap whatsoever. Moreover, Johnson does not disclose a cosmetics dispenser.

The Office Action incorrectly states that Garris teaches a cosmetics case. Applicant respectfully submits that a shaving soap or paste, which is what

Garris' device dispenses, is not a cosmetic. Cosmetics are beauty aids, especially for one's complexion, and shaving soap is not a cosmetic. Accordingly, Garris does not disclose a cosmetics case.

Garris admittedly fails to disclose a cap for its brush 20 or that its dispensing tube has a spring and reversing ball.

In an attempt to remedy the failure to provide a cap for its shaving brush, the Office Action turns to a significantly different type of device, i.e., it turns to Yaneza, which is a toothbrush and toothpaste dispensing assembly, not a cosmetics dispenser.

The Office Action says that it would be obvious to modify Garris and provide a cap to facilitate packing for travel as explicitly taught by Yaneza. Applicant respectfully disagrees because of the significant difference in usage between a shaving brush and a toothbrush, neither of which is a cosmetic case or dispenses cosmetics. In Applicant's experience, whereas toothbrushes are routinely placed in cases for travel, shaving brushes are not. The main reason one places a toothbrush in a case is for personal hygiene because a toothbrush is used inside one's mouth. Shaving brushes are not used inside of one's mouth and do not need a case for hygienic purposes.

Moreover, a cap designed like Yaneza's cap would not encompass or fit over Garris' shaving brush which clearly has a significantly larger diameter than the diameter of its shaving cream storing and dispensing chamber 24. Yaneza's

case can easily be slipped on and off because of the small dimension of the toothbrush bristles whereas a same diameter cover as Garris' handle 1 could not easily slip on and off without damaging the brush and shortening its life. Accordingly, one of ordinary skill in the art would not be motivated to turn to Yaneza to modify Garris.

Furthermore, Garris contain no suggestion of a cap for its shaving brush which Applicant respectfully submits is normally just rinsed with water and dried with a towel after use because there is no need to take the same type of sanitary precautions with a shaving brush as with a toothbrush. There is simply no need to provide a cap for a shaving brush because they are normally rinsed and dried with a towel after use, whereas one does not normally dry one's toothbrush with a towel that is hanging around in a bathroom after use for sanitary purposes.

Accordingly, the Office Action fails to provide objective factual evidence of proper motivation to modify Garris, as suggested, in vies of Yaneza.

Nor does Yaneza even operate like Garris in that its dispenser does not supply toothpaste in the center of the bristles through a hollow tube. This is another reason that one of ordinary skill in the art would not look to Yaneza to modify Garris.

The Office Action then turns to Johnson, who also does not disclose a cosmetics dispensing device.

Johnson does disclose a shaving brush that supplies shaving cream to the interior center of shaving brush 2 via central passage 12 that is closed with a ball 11 and spring 13. Johnson's brush has no cap whatsoever.

The Office Action concludes that it would be obvious to modify Garris to include Johnson's spring and reversing ball to prevent the mass behind the ball from drying out.

Applicant respectfully disagrees. The Garris and Johnson devices have significant differences that teach away from being modified as suggested. Garris, as noted above, fills and dispenses shaving soap from the same end, i.e., the head end where head 19 is located. Garris' brush head 19 is designed to be "disconnected from the handle 1" to replenish the chamber 24 (lines 69-80).

Johnson, on the other hand, is not designed in this way at all. Johnson's barrel reservoir 3 is designed to be filled at the base end via removable plug 15. Johnson's spring and ball assembly is not designed to be removed to replenish the reservoir 3, but to remain fixed in position at the opposite, dispensing, end in head 1.

Applicant respectfully submit that one of ordinary skill in the art would not be motivated to provide the relatively complex spring and ball assembly of Johnson at the head end of Garris because to do so would require a significant

redesign of Garris' brush head 19 and would result in removing Garris' desirable feature of being able to load and dispense the shaving soap from the head end.

Applicant respectfully submits that one would have to totally redesign Garris to modify it as suggested and that one of ordinary skill in the art would not have any incentive to do so.

The Examiner may not pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc., 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987) and In re Kamm, 452 F.2d 1052, 1057, 172 USPQ 298, 301-2 (CCPA 1972), and obviousness cannot be established by locating references which describe various aspects of Applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what Appellants have done. Ex parte Levengood, 28 USPQ2d 1300, 1302 (Bd. App. & Int. 1993).

A fair, balanced view of all three references reveals that (1) none of them discloses cosmetic dispensers, two of the three references, (2) Garris and Johnson differ so significantly that one of ordinary skill in the art would have no incentive to modify Garris in view of Johnson to radically redesign Garris and do away with its single ended replenishing and dispensing feature to

provide a feature that the office Action does not establish (by objective factual evidence) that it needs to function properly, and (3) Yaneza differs so fundamentally in dispensing design and hygienic characteristics from both shaving soap dispensers that the Office Action fails to provide objective factual evidence that one of ordinary skill in the art would be motivated to look to Yaneza to provide a cap for the shaving soap dispensing brushes.

Accordingly, this rejection of claim 1 is improper and should be withdrawn.

New Claims 2 and 3

Applicant respectfully submits that claims 2 and 3 are patentable over the applied art at least for the reasons discussed above regarding claim 1, and because the additional features recited in claims 2 and 3 are neither disclosed nor suggested by the applied art.

Additional Cited References

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8076, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Applicant respectfully petitions under the provisions of 37 C.F.R. § 1.136(a) and § 1.17 for a three-month(s) extension of time in which to respond to the Examiner's Office Action. The Extension of Time Fee in the amount of \$510.00 is attached hereto.

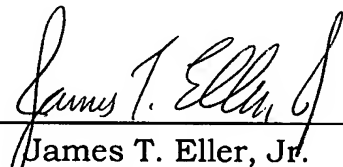
Application No.: 10/671,507
Art Unit 3754


Attorney Docket No. 4653-0105P
Reply to May 6, 2005 Office Action
Page 18

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 
James T. Eller, Jr.
Reg. No.: 39,538

JTE/RJW:/mao/gf 

P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703) 205-8000

Attachment: Abstract of the Disclosure